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IN THE
Supreme Court of the United States.

No. 608. October Term, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

**PETITIONER'S REPLY BRIEF
IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI.**

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE
JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Respondent's brief (in opposition to our Petition for Writ of Certiorari) feigns non-existent dispute of facts.

We would not reply to respondent's brief except for the fact that respondent's brief seeks to avoid a review of this case by this Court, by an attempt to becloud the questions presented by our petition, partly by the discussion of generalities on non-issues (while failing to traverse any of the questions presented by the petition), and partly by attempting to mislead this Court to conclude that the questions submitted by the petition involve issues of fact. But that is not the case, since every alleged issue of fact feigned by respondent, involves nothing more than respondent's ingenious selection of terminology or phraseology differing from that used by petitioner to set forth the facts. Re-

spondent attempts to make it appear as though the facts were in dispute, whereas respondent has merely attempted to becloud the matter by differences in phraseology or nomenclature.

For each of the Argument Points II, III and IV of our Brief heretofore filed, we have assumed (for the purposes of argument) that Butler did invent a new and patentable coupler adapted for coupling a pump to a "headed" grease-cup (or to a "nipple"), and that Butler's coupler worked differently from, and worked better than, the prior-art couplers.

There is no dispute as to the fact that lubricant-dispensing pumps or "grease-guns" and couplers and grease-cups had long been "combined" (or used conjointly). That is the precise "combination" which this Court considered in *Rogers v. Alemite*, 298 U. S. 415.

Nor is there any dispute that "headed" type grease-cups were old and had been "combined" (that is, used with) head-engaging type couplers and grease-guns, as in the Seng patent for instance (R. pp. 541 to 544).

Respondent's only feigned dispute of facts is that while we have assumed for our Argument Points II, III and IV that Butler's head-engaging coupler was new, different and inventive, and that it coupled onto a "headed" grease-cup (or "nipple") in a way different from that in which the prior-art head-engaging couplers coupled onto "headed" grease-cups (or "nipples");

respondent has devised the ingenious scheme of calling the old "combination" (or conjoint use) of a pump, coupler and grease-cup, a "system", and

then arguing that Butler was the first one to devise a "system" (of pump, coupler and grease-cup) in which the coupler worked thus-and-so.

The term "system" is just a convenient euphemism resorted to by respondent throughout its vast campaign of patent litigation under the patent here in suit, as well as under its many other so-called "combination" patents

(each of which claims a so-called "combination" of pump, coupler and grease-cup, in which the novelty, if any, is solely in the coupler)

to disguise the simple fact that respondent is re-claiming an old combination of pump, coupler and grease-cup each and every time an allegedly new grease-delivery nozzle or coupler is invented, and to disguise the further simple fact that for each and every one of the many alleged coupler inventions of respondent's huge pool of so-called "combination" patents, it is in reality asserting a monopoly of old grease-cups and old pumps usable with the assertedly improved coupler of each patent.

This is the catch phrase which respondent succeeded in having the trial court adopt in its opinion and findings of fact and conclusions of law*.

As stated, however, for the purposes of our Argument Points II, III and IV, we have assumed (without conceding)

*Contrary to respondent's repeated representations to the Court of Appeals for the Seventh Circuit in the case at bar, and contrary to its representations to this Court to the effect that the District Court prepared its own findings and conclusions, the trial court's findings and conclusions were practically a verbatim copy of the findings of fact and conclusions of law drafted by respondent's counsel, Mr. Williams, and submitted by him to the trial court prior to the trial court's opinion and findings and conclusions.

that Butler's coupler grips better and seals better and differently from the prior-art head-engaging couplers.

All that respondent's feigned dispute of facts resolves itself into is respondent's argument that as Butler's coupler is new and different, therefore the "system" (of pump, coupler and grease-cup) is also new and different. This is just another way of saying that if Butler's coupler is new, then the "combination" (or use) therewith of the other customary devices (such as an old "headed" grease-cup or an old pump) must also be new. Obviously, however, novelty in such "combination" or "system" is present only in the sense that the old grease pump and old grease-cup were never coupled by a Butler coupler until Butler made his alleged coupler invention. In other words, respondent's entire feigned dispute of facts amounts to nothing more than respondent's attempt to conceal, by an excess of verbiage, that while Butler's asserted invention (if any) is in the internal construction or mechanism of a coupler, respondent nevertheless contends for a monopoly of old headed grease-cups usable therewith. This is precisely the question around which each of Argument Points II, III and IV centers, and by no amount of argument can respondent convert this into a question of fact because it represents a pure question of law.

"Headed" grease-cup or so-called "nipple" (the only defendant's accused device in the case at bar) was conceded by the Circuit Court of Appeals in the case at bar to be an old headed "nipple".

The Circuit Court of Appeals in the case at bar has clearly pointed out in its opinion that the "headed" grease-cup or so-called "nipple" is in and of itself old and unpatentable:—

"In the instant case, it is conceded that the **headed nipple** was **not patented**. More, it is **not patentable**. It will be assumed that it **was old**." (Emphasis supplied.)

(91 Fed 2d 763; R. p. 637)

With this finding by the Circuit Court of Appeals in the case at bar, there is no possible dispute of facts on our Argument Points II, III and IV.

For Argument Points II, III and IV of our brief, we have assumed (without conceding) that Butler's presumably new coupler coupled the old pump and old "headed" grease-cup (or "nipple") differently and better than they had ever before been coupled by the prior-art couplers.

The question of law still remains the same, however, namely, whether one who invents a presumably better coupler, that is, a coupler which will couple the old grease-pump and old grease-cup better than they had ever been coupled before, may also have a monopoly on the old grease-cup and old grease-pump which are to be so coupled by (or used with) the presumably new coupler.

In Argument Points II, III and IV, we have successively pointed out each of three different legal reasons why the inventor of a presumably different and better (and patentable) coupler which may be used for coupling an old grease-pump to an old grease-cup, better than they had ever been coupled before by the prior-art couplers, should **not** be permitted to have a monopoly of the old grease-pump or the old grease-cup which are so to be used with (and presumably better coupled by) the patentee's presumably better coupler.

Rogers v. Alemite, 298 U. S. 415

In our Argument Point II (which covers our certiorari ground No. 2) we have relied upon this Court's decision in *Rogers v. Alemite* where, as in the case at bar, Gullborg was presumed to have invented a different and better coupler (of the "bayonet" type) and then* claimed the so-called "combination" or "system" of old pump, new coupler and old grease-cup. In the *Rogers v. Alemite* case, respondent also urged upon this Court that not only was the coupler new, but the entire "combination" or "system" was likewise new because the old pump and old grease-cup had never before been coupled by Gullborg's new, different and better coupler. This Court in that case assumed that Gullborg's coupler was new, different and better and *did* couple the old grease-pump and the old grease-cup in a way different from and better than they had ever been coupled before by the prior-art couplers. Nevertheless, this Court held that respondent was **not** entitled to a monopoly of the old grease-cup and old grease-pump which was to be coupled by Gullborg's different and better coupler.

This certainly involves no questions of fact in the case at bar, because we have assumed for purposes of Argument Point II (without conceding) that Butler's coupler is different from and better than the prior-art couplers and works differently, that is, it grips better and seals better than the prior-art couplers.

Respondent's beclouding strategy is the same as that unsuccessfully used by it in *Adams v. Bassick* (285 U. S. 531) and *Rogers v. Alemite* (298 U. S. 415) and consists of the repeated cry that "this court is asked to decide *questione de novo*."

* (in claims 1 to 6 and 8 & 10)

Respondent's attempt to avoid a review of this case by this Court involves the same beclouding strategy employed by it in opposing the petition for writ of certiorari before this Court in the case of *Adams Grease Gun Corp. v. Bassick Mfg. Co.* (No. 649, October Term 1931) where, as here, respondent's cry was that the questions presented by the petition required a de novo consideration by this Court of the underlying facts.

This Court granted the petition for writ of certiorari in the *Adams v. Bassick* case (285 U. S. 531) on precisely the same grounds which constitute our certiorari ground No. 4, which are covered by our Argument Point IV, although in the *Bassick v. Adams* case there was then no actual conflict with respect to the same patent. In that case, respondent¹ after unsuccessfully opposing the petition for writ of certiorari, preferred to settle with the *Adams Grease Gun Corporation* the day before the case came up for hearing before this Court and caused the *Adams Grease Gun Corporation* to withdraw its appeal.

The same beclouding strategy through which respondent attempts to avoid a review of this case by this Court was also relied upon by it in its brief before this Court in *Rogers v. Alemite* (No. 31, October Term 1935) where, as here, it again sought to avoid a discussion of the real issues by contending (as it does in the case at bar) that

"this Court is asked to decide these questions de novo etc."²

1) the respondent in that case and the respondent in the case at bar are the same, insofar as *Bassick Mfg. Co.* (more recently re-named as the *Alemite Corporation*) was and is a wholly owned subsidiary of the *Stewart-Warner Corporation*.

2) Page 9 of respondent's brief in *Rogers v. Alemite* No. 31 October Term 1935 (298 U. S. 415).

Respondent urged upon the Circuit Court of Appeals in the case at bar that this Court's decision in the case of *Rogers v. Alemite* (298 U. S. 415) was erroneous, illogical and difficult to understand.

While respondent in the case at bar tries to distract this Court's attention from the real and vital conflict existing between the decision of the lower courts in the case at bar and the decision of this Court in the *Rogers v. Alemite* case (298 U. S. 415), respondent did not hesitate to urge upon the lower courts in the case at bar (as openly as the bounds of propriety might permit it to do so) that this Court's opinion in the *Rogers v. Alemite* case was erroneous.

Thus, on pages 63 and 64 of his brief in the Court of Appeals for the Seventh Circuit in the case at bar, respondent's counsel (Mr. Williams) said:—

“It was of course Mr. Kalish himself who bundled together the many cases of license by implication,—in other words, license by virtue of estoppels arising out of the patentee's conduct, and cases holding certain claims of certain patents to be invalid on the score of aggregation, and cases holding certain restrictive clauses of certain license contracts to be violative of the anti-trust laws. In a foot-note to his opinion, Mr. Justice Roberts cited this grist of distinctive and wholly unrelated cases in support of his negative answer to his question,

‘whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element.’ (Citation 298 U. S. at p. 425.)

"We have found it quite impossible to reconcile the long list of diverse cases cited by the Supreme Court, with any logical understanding of or answer to the question formulated by Mr. Justice Roberts, or with his answer to it." (Emphasis supplied.)

Again on page 65 of his brief, respondent's counsel (Mr. Williams) further said to the Circuit Court of Appeals (in the case at bar):—

"It would seem clear that the real ground of the decision was 'double patenting,'—the simple proposition that an inventor is not entitled to two separate patents upon one and the same invention. (Nevertheless, it was in this connection that Mr. Kalish's grist of unclassified and disparate cases were listed, without comment or analysis, in an accompanying foot-note.)"

"The only difficulty in understanding and applying the decision of the Supreme Court in the Rogers case results from the comment which the Court made relative to the Berliner patent No. 534,543, which was involved in the Leeds & Catlin case. The Court said that

'There the patent was a pioneer patent, and the combination was of elements which were novel and neither of which possessed utility without the other. Each element was necessary to the operation of the other. The invention did not, as here, consist of the mere improvement of one element of an old combination.' " (Emphasis supplied.)

It was responsive to this type of argument that the trial court in the case at bar characterized this Court's opinion in the Rogers v. Alemite case as "startling"¹ and that the Circuit Court of Appeals in the case at bar characterized

1) 15 F. Supp. 571, 577, first line of last paragraph in left column.

this Court's ruling in the *Rogers v. Alemite* case as a "novel proposition".²⁾

Respondent further urged upon the Court of Appeals for the Seventh Circuit in the case at bar (on pages 66 and 67) of its brief:—

"We believe that these matters deserve the careful attention of this Court because, if the decision of the Supreme Court in the *Rogers* case means what counsel for the appellant would have it mean, then certainly there has been a revolution in all of the patent law as understood and applied by this and every other Federal Court throughout the entire history of the patent system.

"An examination of our compilation of the opinions of this Court will convince your Honors that if the Supreme Court really intended on May 18, 1936 to overturn all of the law of the *Leeds & Catlin* cases, it would be highly desirable in the interests of everyone concerned, to give the Supreme Court an opportunity to make that intention far more clear and definite than it has been made in and by its decision in the *Hollingshead* and *Rogers* cases, 298 U. S. 415 (80 L. Ed. 782)." (Emphasis supplied.)

Thus, while respondent seeks to distract this Court's attention from the clear-cut and unmistakable conflict with this Court's own opinion in the *Rogers v. Alemite* case, respondent clearly urged upon the Circuit Court of Appeals for the Seventh Circuit in the case at bar

that this Court's decision in the *Rogers v. Alemite* case was erroneous and that such error was induced

2) 91 Fed (2d) 757, 761, next to the last paragraph in left column.

by allegedly unrelated authorities relied upon by us and cited by Mr. Justice Roberts in the last footnote forming part of this Court's opinion; and that the Circuit Court of Appeals in the case at bar should **not** follow this Court's ruling in the Rogers v. Alemite case but that instead this Court be merely given another opportunity to make itself clear and definite (before its decision in the Hollingshead and Rogers cases is to be followed).

The Conflict between the Circuit Court of Appeals for the Eighth Circuit in the Jiffy Case and the Circuit Court of Appeals in the Seventh Circuit in the case at bar.

In our brief we have quoted in the Appendix II, pages 5a to 8a inclusive, statements of respondent's counsel, Mr. Williams, to the Circuit Court of Appeals in the case at bar, to the effect that in order for Circuit Court of Appeals to decide this case in favor of respondent, it was necessary for the Circuit Court of Appeals for the Seventh Circuit "**to reach a different conclusion**" from that reached by the Circuit Court of Appeals for the Eighth Circuit with respect to the **same** patent.

Respondent's brief does not deny what respondent clearly admitted to the Circuit Court of Appeals in the case at bar, namely, that a decision for respondent **must** inevitably **conflict** with the decision of the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case. **It does so conflict.** To secure this conflict, respondent throughout its brief to the Circuit Court of Appeals for the Seventh Circuit argued the alleged error of the Eighth Circuit in the Jiffy case:

"the decision of the Eighth Circuit Court of Appeals was based upon such an untenable and impossible un-

derstanding of the physical construction of the Butler device" 2)

"Judge Lindley gave ample reasons, although not all of the reasons, which might have been given for disregarding the dictum as well as irrelevant holdings of the Eighth Circuit Court of Appeals in the Jiffy case" 3)

"the Eighth Circuit Court of Appeals adopted a fantastic contention advanced by the Jiffy Company's expert to the effect that the spring fingers must for some unknown reason extend the full length of the tubular extension 42" 4)

"the Eighth Circuit Court of Appeals reached its conclusions as a result of an erroneous and untenable misconception of the structure and mode of operation of the device illustrated and described in the Butler patent in suit" 5)

A reading of the excerpts from respondent's briefs addressed to the Court of Appeals for the Eighth Circuit in the Jiffy case, which we have quoted on pages 1a to 4a of Appendix I annexed to our Brief heretofore filed in this Court, clearly shows that respondent not only placed its own "Alemite Hydraulic" coupler in issue in the Jiffy case to show "commercial success", but also in the distinct (though unsuccessful) effort to get the courts in the Jiffy case to give the coupler part of the Butler claim-language

2) Page 8 of respondent's brief in the Circuit Court of Appeals for the Seventh Circuit in the case at bar.

3) Respondent's brief, page 8, in the Circuit Court of Appeals for the Seventh Circuit in the case at bar.

4) Respondent's brief, page 23 in the Seventh Circuit Court of Appeals.

5) Respondent's brief, page 25, in the Seventh Circuit Court of Appeals.

a broad enough interpretation to cover the Jiffy coupler which respondent urged was substantially identical with respondent's own "Alemite Hydraulic" coupler.

These facts, plus the fact that the coupler part of the claim-language of Butler claims 1 and 2 are indistinguishable, as illustrated on pages 13 and 14 of our Brief heretofore filed, can leave no doubt that the decision of the Circuit Court of Appeals for the Seventh Circuit in the case at bar is definitely in conflict with the decision of the Court of Appeals for the Eighth Circuit in the Jiffy case, with respect to the scope of the Butler patent.

CONCLUSION.

In conclusion, we respectfully submit that not only is there present here a distinct and definite conflict between the Court of Appeals for the Eighth Circuit and the Court of Appeals for the Seventh Circuit, with respect to the scope of the same patent here in suit (which conflict was admitted by respondent's counsel before the Court of Appeals for the Seventh Circuit*), but there is also present here a definite and unmistakable failure on the part of lower courts to follow a clearly controlling decision of this Court (Rogers v. Alemite, 298 U. S. 415).

It is earnestly urged that the Petition for Writ of Certiorari be granted.

Respectfully submitted,

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*See pages 5a to 8a of Appendix II annexed to our Brief heretofore filed on November 29, 1937.